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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/383,094	08/25/1999	NEMO SEMRET	A32159-07005	6099

21003 7590 04/24/2002

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EXAMINER	
RIMELL, SAMUEL G	
ART UNIT	**PAPER NUMBER**
3626	

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

cd

Office Action Summary	Application No. 09/383,094	Applicant(s) SEMRET ET AL.	
	Examiner Sam Rimell	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 8-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 8-12 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

SAM RIMELL
PRIMARY EXAMINER
AU 2166

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lazar et al.

The reference to Lazar et al. is the "Appendix A" to PCT WO 01/88811 entitled "Design and Analysis of Progressive Second Price Auction for Network Bandwidth Sharing". This Appendix has a separate title and separate publication dates from the PCT document and is considered to be a separate document from the PCT document WO 01/88811.

Footnotes to the Lazar et al. reference indicate that the information in the reference was released in a conference dating back to April 1997 (see bottom of page 1). Accordingly, the reference is applied under 35 USC 102(b), even though it contains the same inventive entity as the present application under examination.

Lazar et al. discloses an access line interface (processor) which separates first stage lines and second stage lines. The first stage lines are those which carry packets of information containing all bids (page 19, last paragraph). The second stage lines are those which carry packets containing a clearing price (based on the highest bid) which are further distributed through the network. The processor which stands at the interface between the first stage lines and second stage lines may either be a router (page 19, last paragraph) or a server (page 45, third paragraph).

No patentable weight are attributed to any of the method steps carried out by the processor. Accordingly, no patentable weight is attributable to the method steps defined by

claims 8, lines 8-29. In addition claims 9-12 are addressed entirely to method steps and no patentable weight is attributed to these method steps. This occurs because the preamble of claim 8 defines the invention in terms of hardware and not in terms of process steps.

However, patentable weight could be attributed to the method steps of claims 8-12, by clarifying that the processor "includes computer readable media encoded with instructions to perform the steps of..." Without such language, the method steps merely become an intended usage of the processor for which no patentable weight can be attributed. *In re Casey* 152 USPQ 235 (CCPA 1967) and *In re Otto* 136 USPQ 458, 459 (CCPA 1963).

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

Sam Rimell
Primary Examiner
Art Unit 2166